

### REMARKS

With regard to the requirement for restriction which is the only point raised in the Official Action, Applicant hereby provisionally elects to prosecute Group I, regarding formula I, covering claims 1-11, 14 and 21-24 partially and claim 12, where Y = oxygen, with traverse, and reserves the right to file a divisional application or to take such other appropriate measures as deemed necessary to protect the invention of Group II. Applicant, was also informed that under the rejoinder rule, group 15 would be eligible for rejoinder if claims in Group I are deemed allowable.

Applicant believes that the elected preparation claims are so closely related to the non-elected process claims, that they should remain in the same application to preserve unity of invention.

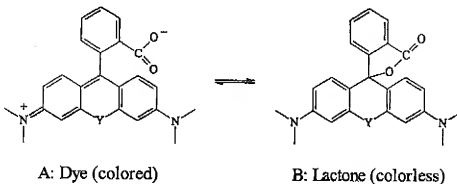
The Examiner states that in view of the X-rated references with respect to  $Y=O$ , the restriction is proper. In response, applicant submits that with respect to the WO00/64988 reference, the ortho-COOH-group in the 1<sup>st</sup> step is converted into phosphooxychloride in examples 5 and 16, which is only possible with very robust dye stuffs of the named compound 9. This process is not generally applicable as compared to the process claimed here which is based on the use of N-hydroxysuccinimide -(NHS-) ester.

Furthermore, with respect to WO 02/055512 reference, examples 1, 5 and 14 are shown to utilize NHS esters of fluorescein and naphtafluorescein; however, no details of the preparation are set forth.

With respect to the EP 167 998 reference, phosphooxychloride is utilized

for the synthesis, which is only possible in rare cases due to its high reactivity and is not suitable when secondary amines are utilized, which further carry functional groups e.g. COOH. Accordingly the only examples shown are those with simple alkyl-substituents (methyl and ethyl).

Moreover, the special technical feature which all the dye stuffs have in common is the ortho-carboxy-phenyl substituents at the central chromophore. The phenyl-group can be additionally substituted or it can also be either a naphthyl, pyridyl or cyclohexyl-group or similar. Essential is only the ortho-COOH-group (generally COOH group which is adjacent to the coupling site of the ring-shaped substituent with the chromophore). Such compounds form in solution an equilibrium between the dye stuff A and a lactone-form B, which in the visible light does not absorb nor fluoresce.



While COOH groups are actually suitable for coupling to  $\text{NH}_2$  groups, for example a protein, this is not the goal here. The coupling takes place but the resulting primary amide immediately forms a lactam, which, similar to the lacton, does not absorb nor fluoresce. The purpose of the fluorescent marking of the biomolecule would thus have no purpose, which is discussed on page 1 of the specification. In the present invention, the ortho-COOH group is converted into a secondary amide

function, so that no lactam can form. A COOH group suitable for coupling or another function is provided via a hydrocarbon chain.

The instant patent application is based on an international PCT application pursuant to Chapter II, whereby during the examination of the international patent application, the unity of the invention was not disputed.

It is believed that the Examiner is trying to draw too fine a line of distinction and that when all the various facts are taken into account, all claims on file should be examined on the merits. In any event, Group I and hence claims 1-11, 14 and 21-24 partially and claim 12, where Y = oxygen, are entitled to action on the merits.

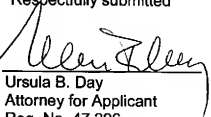
Since applicant has fully and completely responded to the Official Action and has made the required election, this application is now in order for early action on the merits of claims .

It is noted that each named inventor of the subject matter of the instant application contributed at least to one of the claims, presently on file.

The Commissioner is hereby authorized to charge any fees which may be required or credit any overpayment to Deposit Account No.50-1747.

Respectfully submitted

By



Ursula B. Day  
Attorney for Applicant  
Reg. No. 47,296

Date: August 18, 2008  
708 Third Avenue, Suite 1501  
New York, N.Y. 10017  
(212) 244-5500  
UBD:kh